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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/612,543 | 07/07/2000 | Makoto Funabashi | 1982-0153P | 9387 |
| 7590 | 04/26/2005 | | EXAMINER | |
| Birch Stewart Kolasch & Birch LLP P O Box 747 Falls Church, VA 22040-0747 | | | CLEVELAND, MICHAEL B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1762 | |

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|---|------------------------|---------------------|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) |
| | 09/612,543 | FUNABASHI, MAKOTO |
| | Examiner | Art Unit |
| | Michael Cleveland | 1762 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 08 March 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 14-19.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4, 6-13 and 20.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).

13. Other: _____.


Michael Cleveland
Primary Examiner
Art Unit: 1762

DETAILED ACTION

1. Applicant's arguments filed 4/12/2005 have been fully considered but they are not persuasive.

Applicant's declaration under 37 CFR 1.132 filed 4/12/2005 is insufficient to overcome the rejection of claims 1-4, 6-13, and 20 based upon Weiss and Leblans as set forth in the last Office action because: it has not been entered because the declaration failed to overcome all rejection and because Applicant failed to provide a showing of good and sufficient reasons why the declaration is necessary and was not earlier presented.

Applicant argues that there is no discussion of *In re Burhans* or *In re Gibson* and that the application in question is directed to a more sophisticated technology than the production of whole wheat flour or mixing brake shoe fillers. The current case is very similar to that of *In re Burhans* in that the art demonstrates that each of the claimed steps is known in the art, but Applicant claims them in a different order. As stated in *In re Burhans*:

Appellant contends that the references taken singly or together do not teach his characteristic four steps which are new in the art and which are necessary to obtain the desired result. There is no merit in the point here in the absence of any proof in the record that the order of performing the steps produces any new and unexpected results. See *In re Gibson*, 17 C.C.P.A. (Patents) 1090, 39 F.2d 975, 5 USPQ 230 ; *In re Lang et al.*, 25 C.C.P.A. (Patents) 1322, 97 F.2d 626, 38 USPQ 187 ; *In re McKee*, 23 C.C.P.A. (Patents) 1187, 83 F.2d 819, 29 USPQ 493 .

Applicant argues that the present case is directed to a more sophisticated technology. The argument is unconvincing because it is clear from the above citation that the principle is recognized to apply regardless of the area of technology because the cases cited by the court are from widely disparate areas: brake shoes (Gibson), dietary liquids (Lang), and wrapping meat (McKee). Therefore, it is clear that the principle applies regardless of the nature of the technology. Furthermore, the nature of the steps in the present case are very simple mechanical processes of mixing and wet classifying.

Applicant argues that the Examiner has not compared the degree of unpredictability of the factors involved in the present case with those of Burhans or Gibson. There is no evidence currently of record of unpredictability regarding the order of the mixing and classifying steps in the present application.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Cleveland
Primary Examiner
Art Unit 1762

4/22/2005